

REMARKS

Claims 7 and 12-29 are all the claims pending in the application.

Claims 7 and 12-29 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over US 6,355,232 to Kaneko et al. and EP 092852 (hereinafter EP '852) in view of US 5,294,444 to Nakamura et al., or Nakamura et al. in view of Kaneko and EP 092852, and further in view of JP-A-04-193814 (JP '814) or JP 63-192703 (JP '703).

In the present Office Action, JP '814 and JP '703 are newly cited and relied upon by the Examiner as allegedly teaching preparation of a ceramide composition without the need of anionic surfactants. Essentially, it is the Examiner's position that because Nakamura combined with Kaneko or EP '852 teaches a transparent or semi-transparent cosmetic composition comprising an amphiphatic lipid, nonionic surfactant, ionic surfactant, and ceramide of formula (I), and since JP '814 and JP '703 teach a preparation of a ceramide composition without the need of anionic surfactants, it would have been obvious to exclude an ionic surface active ingredient from asserted combination of Nakamura combined with Kaneko to arrive the present invention.

Applicants respectfully traverse.

Claim 7 is the only independent claim. Independent claim 7 is directed to a method of preparing a clear aqueous cosmetic additive composition suitable for use in cosmetics, said composition being free of an ionic surface active agent and being not irritating to the skin.

It is respectfully submitted that none of the cited references, either taken alone or in combination, disclose or render obvious the features of the instantly claimed method of preparing a clear aqueous cosmetic additive composition, as recited in claim 7 of the present application.

In particular, Nakamura relates to a cosmetic composition comprising (A) 0.05-30% by weight of an amphiphatic lipid, (B) 0.05-30% by weight of a nonionic surfactant, (C) 1-50% by

weight, based on (b), of an ionic surfactant, and (D) 40-99% by weight of an aqueous medium, wherein said composition is transparent or semi-transparent, and wherein the ratio of (A)/[(B)+(C)] is 0.2-10, which is beautifully transparent or semi-transparent, and in which the amphiphatic lipids are stably microdispersed. (See Nakamura, Abstract).

Nakamura specifically discloses that component (C) is used in an amount of 1-50% by weight, preferably 2-30% by weight based on the weight of component (B). If the amount of the (C) is out of this range, the cosmetic composition will not be adequately transparent or semi-transparent. (See Nakamura, Col. 3, lines 55 to Col. 4, line 3). That is, if one of ordinary skill in the art *were* to combine Nakamura with JP '814 or JP '703 to exclude the “ionic surface active agent” from cosmetic composition of Nakamura, as suggested by the Examiner, the obtained composition would not be transparent or semi-transparent.

Therefore, contrary to the Examiner's assertion, one of ordinary skill in the art would not be motivated to modify the cosmetic composition of Nakamura to exclude the ionic surface active agent, because the intended function of the cosmetic composition of Nakamura would be changed or impaired if modified to exclude the ionic surface active agent as suggested by the Examiner.

“[I]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The prior art must be considered in its entirety, including disclosures that teach away from the claims and the Examiner's assertion that the present rejection provides a motivation to exclude an ionic surfactant because of its skin and eye irritating properties is simply incorrect. (See MPEP 2141.02).

In view of the foregoing, it is respectfully submitted that there is no motivation to combine the cited references; even if the reference were somehow combined, the suggested combination of Kaneko and EP 092852 in view of Nakamura., or Nakamura in view of Kaneko and EP 092852, and further in view of P '814 or JP '703 would not have arrived at the claimed subject matter. Accordingly, withdrawal of the foregoing rejections under 35 U.S.C. §103(a) is respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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